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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,549	02/14/2007	Marcos De Godoy	17170/18001	5736

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EXAMINER

DESAI, NAISHADH N

ART UNIT	PAPER NUMBER
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2834

NOTIFICATION DATE	DELIVERY MODE
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08/25/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/558,549	Applicant(s) DE GODOY ET AL.	
	Examiner NAISHADH N. DESAI	Art Unit 2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-17 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what applicant means by "...angularly immobilizing..." Which angle? In which direction?. Appropriate correction is required. Also regarding the limitation ..."configured to cooperate with one another..". Appropriate correction is required.

Claim Rejections - 35 USC § 102

Claims 7-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Soh (US 5,943,909).

2. Regarding independent claim 7, Soh teaches:

A starter for a thermal combustion engine of a vehicle, comprising (abstract):

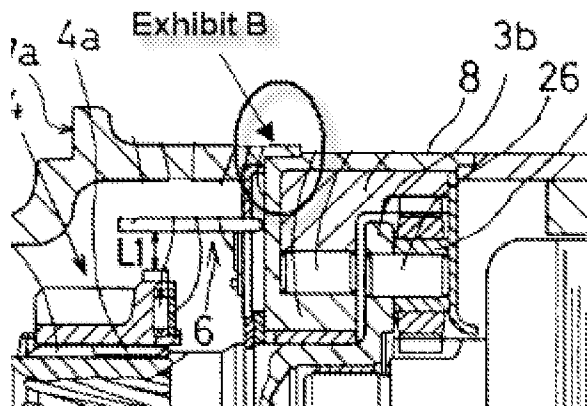
an electrical engine comprising a cylindrical head (Fig 1,8); and

an interfacing support to be mounted on the thermal combustion engine (abstract ,Fig 1 elements 7 and 51), said interfacing support being assembled with the cylindrical head and having an outer surface (Fig 1,7,8), wherein the cylindrical head comprises one of a projection and a slot (Fig 2,8c), and the interfacing support comprises on its outer surface the other of the projection and the slot (Fig 2,51e), and

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wherein the projection and the slot are configured to cooperate with one another (Fig 4) both for angularly immobilizing the cylindrical head relative to the support (Fig 1, shows that the interfacing support (elements 7 and 51) and that the protrusion of the cylindrical head (element 8c) fits into the slot (element 51e) to angularly immobilize the structure in relation to each other) and for forming a water evacuation outlet orifice (Fig 4, 54, J and abstract). Soh does not literally teach the device to be used for a thermal combustion engine. However, examiner notes that it is well known to use these sorts of starter devices for a thermal combustion engine. It would have been obvious to use this device in a thermal combustion engine since it would allow the use of a compact and efficient accommodation within the engine compartment of the vehicle (Col 1 ll 37-39).

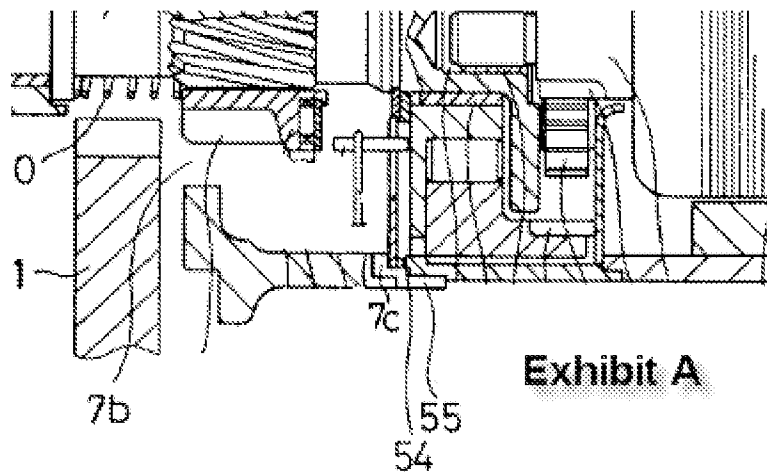
3. Regarding dependent claim 8, Soh teaches that the interfacing support has one or more slots for receiving the projection (See re-illustration of Soh's figure 1, exhibit B below).



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4. Regarding dependent claim 9, Soh teaches that the slot is integrated in the circular contact of the support (See re-illustration of Soh's figure 1, exhibit B above. Also Fig 1,7d).

5. Regarding dependent claim 10, Soh teaches that the water evacuation is performed through a baffle (See re-illustration of Soh's figure 1,7c,54 ,55 and exhibit A below. Also Fig 4 and Col 7 ll 3-27).



6. Regarding dependent claim 11 and 12, Soh teaches that the water evacuation is direct through the outlet orifice (See re-illustration of Soh's Figure 1,7c,54 ,55 and exhibit A above. Also Fig 4 and Col 7 ll 3-27).

7. Regarding dependent claim 13, Soh teaches that the outlet orifice is configured such that the water is evacuated through the outlet orifice along an axial direction (See re-illustration of Soh's Figure 1,7c,54 ,55 and exhibit A above).

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8. Regarding dependent claim 14, Soh teaches that the outlet orifice is configured such that the water is evacuated through the outlet orifice along an radial direction (See re-illustration of Soh's Figure 1,7c,54 ,55 and exhibit A above).

9. Regarding dependent claim 15, Soh teaches that the projection extends axially (See re-illustration of Soh's Figure 1 and exhibit B above).

10. Regarding independent claim 16, Soh teaches:

A starter for a thermal combustion engine of a vehicle, comprising (abstract):

an electrical engine comprising a cylindrical head (Fig 1,8), said cylindrical head comprising an axial projection extending from a frontal end of the cylindrical head (Fig 2,8c);

an interfacing support to be mounted on the thermal combustion engine (Fig 1,7 ,51 and abstract), said interfacing support being assembled with the cylindrical head (Fig 1,7,51 and 8), and

comprising a clearance (Fig 4,B) configured to receive the projection of the cylindrical head (Fig 4,8c of Soh) for angularly immobilizing the cylindrical head relative to the support (Fig 1, shows that the interfacing support (elements 7 and 51) and that the protrusion of the cylindrical head (element 8c) fits into the slot (element 51e) to angularly immobilize the structure in relation to each other) and for forming a water evacuation outlet orifice (Fig 4,7c,54 and J of Soh). Soh does not literally teach the device to be used for a thermal combustion engine. However, examiner notes that it is

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well known to use these sorts of starter devices for a thermal combustion engine. It would have been obvious to use this device in a thermal combustion engine since it would allow the use of a compact and efficient accommodation within the engine compartment of the vehicle (Col 1 ll 37-39). Examiner also notes that the use of mating surfaces having projections and slots is well known.

11. Regarding dependent claim 17, Soh (Fig 4) teaches that the water evacuation outlet orifice comprises an axial portion formed between the projection of the cylindrical head and the interfacing support.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claim 12 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 11. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for details.

Response to Arguments

14. Applicant's arguments with respect to claims 7-17 are moot in view of the new grounds of rejection. Examiner notes applicant's cancellation of claims 1-6.

15. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naishadh N. Desai whose telephone number is (571) 270-3038. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on (571) 272-2204. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Naishadh N Desai
Patent Examiner

/Karl I.E. Tamai/
Primary Examiner, Art Unit 2834

August 20, 2008